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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/792,142      | 03/03/2004  | George H. Forman     | 10007903-2          | 4833             |

7590 03/23/2005  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

HUFFMAN, JULIAN D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2853

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                   |                   |  |
|------------------------------|-------------------|-------------------|--|
| <b>Office Action Summary</b> | Application No.   | Applicant(s)      |  |
|                              | 10/792,142        | FORMAN, GEORGE H. |  |
|                              | Examiner          | Art Unit          |  |
|                              | Julian D. Huffman | 2853              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

species 1, wherein the memory is an electrically readable device (such as a EEPROM)

species 2, wherein the memory is an optically readable device (such as a CD or DVD); and

species 3, wherein the memory is a magnetically readable device.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 5-7 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Philip S. Lyren on 18 March 2005 a provisional election was made with traverse to prosecute the invention of species 3, claims 1 and 4-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2 and 3 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Double Patenting***

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 7 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,802,586 B2. This is a double patenting rejection.

In the prior office action the previous examiner applied a nonstatutory rejection of the claims. That rejection has been overcome by the filing of the terminal disclaimer. The present rejection is a statutory rejection solely of claim 7, which is identical to claim 1 of the 586 patent. This rejection is not/cannot be overcome by the terminal disclaimer.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by 1.2 GB Firmware Utility developed by Apple Computer, Inc.

Applicant's claim 4 is directed towards a magnetic storage device storing upgrade program code. The invention is described in applicant's specification on the top of page 8.

Apple Computer, Inc. developed a firmware update utility for a hard drive of a personal computer. In the process of performing the update, a user stores a program code on a magnetic media, inserts the magnetic media and reboots the computer. The computer then runs the program code from the magnetic media and, through menus, guides the user to update the firmware of the hard drive. The relevant document describes the steps performed by the code and instructions for performing the upgrade.

The program was released on October 21, 1997 and provides evidence that the claimed invention was known and used by others and also in public use more than one year prior to applicant's effective filing date.

These types of firmware upgrades are well known in the art. One or more CD's, floppy disks or other removable/consumable media are typically used to store the upgrades.

Apple Computer, Inc. discloses a computer consumable component (floppy disk) employed with an associated computerized apparatus, comprising:

- the consumable component (floppy disk);

- incorporated with the consumable component, a magnetically readable memory (magnetic disk);

- embedded in the memory, readable program code associated with a device selected from a group including, the consumable component (since the code is stored on the disk, it is associated with the floppy disk), the associated computerized apparatus (the computer uses the code to update the firmware of the hard-drive), and interactional program code associated with both the consumable device and the associated computing apparatus (program code read from the floppy disk is used by the computer to guide the user to perform the upgrade);

- interactive subroutines for allowing selection of options for installation, operation or both, of said readable program code (see steps 4 and 5 on page 2, note that the computer is being booted from the floppy, as stated in the second paragraph under the

heading "Overview", since the hard-drive cannot undergo normal operation during an upgrade);

program code for determining if the readable program code is compatible with the associated computerized apparatus, and, if not, program code for aborting any downloading of the readable program code (page 2, step 4); and

program code indicating whether the readable program code is a partial listing or a complete listing of an upgrade version thereof (since firmware updates may be performed using a plurality of floppy disks, for example, if larger storage capacity is required for the program, the program code must include code to indicate that the program is a complete listing of an upgrade version and does not require additional disks).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See column 5, lines 19-25 of U.S. 5,930,553 to Hirst et al.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (571) 272-2147. The examiner can normally be reached on 9:30a.m.-6:00p.m. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2853

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH

JH  
18 March 2005

  
**Stephen D. Meier**  
Primary Examiner